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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 061047-0268225 | |
|---|--------------------------------------|--|--|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____ | Application Number 09/943,086 | Filed August 31, 2001 | |
| | First Named Inventor ASAY | | |
| | Art Unit 2137 | Examiner P. CALLAHAN | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 42,663 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | |
| <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p> | | | |



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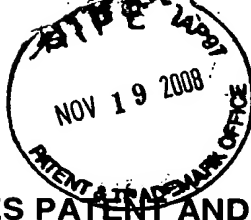
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November 19, 2008

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
ASAY *ET AL.*

Confirmation Number: 8118

Application No.: 09/943,086

Group Art Unit: 2137

Filed: August 31, 2001

Examiner: P. CALLAHAN

Title: RELIANCE SERVER FOR ELECTRONIC TRANSACTION SYSTEM

**ATTACHMENT SHEETS TO
PRE-APPEAL BRIEF CONFERENCE REQUEST**

In response to the Final Office Action dated August 19, 2008 ("Office Action"), Appellant hereby requests that a panel of examiners formally review the legal and factual basis of the rejections in the above-identified application prior to the filing of an appeal brief. This request is being concurrently filed with a Notice of Appeal. The review is requested for the reasons provided in the Arguments for Traversal below.

APPEALED REJECTION

Appellant traverses and appeals the rejection of claims 1, 57-61 and 63-75 under 35 U.S.C. §103(a) as being obvious in view of United States patent no. 5,815,657 to Williams et al. ("Williams") further in view of European patent application publication no. EP 0512702 to Donner et al. ("Donner").

ARGUMENTS FOR TRAVERSAL

Williams

Williams discloses an electronic transaction system wherein a consumer can graphically select a payment method of their choice and, once selected, a summary of the goods for purchase are presented to the consumer. The consumer then enters an electronic approval for the transaction or cancels the transaction.

In stark contrast, claim 1 generally recites a method comprising processing a request for transactional financial assurance of a subscriber transaction to determine whether to provide the requested transactional financial assurance to a relying party, the determination based on at least a subscriber assurance of an attribute of a subscriber to the system, the subscriber assurance issued by a certification authority.

For an example embodiment, Appellant refers to pgs 6-7 of Appellant's Response filed May 13, 2008 ("May 13, 2008 Response").

Accordingly, Appellant respectfully submits that the cited portions of Williams clearly fail to render obvious a method of managing reliance in an electronic transaction system as recited in claim 1 at least for the reasons discussed herein.

Williams fails to render obvious "obtaining electronic signals representing a request for transactional financial assurance based on a transaction involving a subscriber, the transactional financial assurance being other than any payment request or payment authorization of the transaction itself" as recited in claim 1

The Office Action asserts that "the Payment Manager [of Williams] receives the request for transactional assurance (i.e., authorization to pay or payment) from the merchant and receives certificate information from the user (user's wallet manager)." However, the cited portions of Williams merely disclose a Payment Manager that acts as a conduit to direct, to the customer, a merchant's request for payment by the consumer and to handle the payment from the consumer to the merchant, the consumer and merchant assuming the risks regarding the transaction with each other. There is simply no indication that the merchant makes any type of request to the Payment Manager for financial assurance as claimed regarding a transaction with the consumer.

A request for payment is not a request for a financial assurance regarding the transaction as claimed; rather, it is simply a request for a constituent component of the transaction. Indeed, claim 1 recites a request for transactional financial assurance based on the transaction, the transactional financial assurance being other than a payment request or payment authorization of the transaction itself. Further, the request for payment by the merchant and the authorization of payment by the consumer in Williams do not provide any form of financial assurance of the transaction. Each of the merchant and the consumer in Williams surely realize that the other may be fraudulent, insolvent, etc. Thus, the system in Williams does not provide financial assurance regarding the transaction; it merely forwards the payment request from the merchant to the consumer and facilitates the consumer's payment. If the consumer is insolvent, clearly the consumer's authorization of the payment assures nothing. Similarly, if the merchant has no goods, the request for payment assures nothing.

The Office Action further asserts that “Williams also teach receipt of certificate information from a customer wallet manager, which constitutes assurance of intent and an ability to pay.” Respectfully, that is not a request for anything. Further, Applicant traverses the new argument that receipt of certificate information from a customer wallet manager “constitutes assurance of intent and an ability to pay”. The Office Action has set forth no support from Williams for this assertion. Moreover, Appellant submits this is nevertheless irrelevant as the Office Action appears to assert that the authorization to pay allegedly constitutes the transactional financial assurance.

Williams fails to render obvious “determining whether to provide the requested transactional financial assurance based on at least the subscriber assurance” as recited in claim 1

The Office Action asserts that “Payment Manager will not provide payment authorization if there is no receipt of a certificate message from the consumer.” Appellant traverses this new argument and requests documentary evidence in Williams supporting such. Appellant can not find any disclosure or teaching in the cited portions of Williams regarding the Payment Manager making any decision based on the consumer certificate or its absence, let alone whether to provide transactional financial assurance. As noted above, payment authorization in the transaction between the consumer and the merchant is not the financial assurance as claimed. Moreover, assuming *arguendo* that the consumer certificate constitutes the recited subscriber assurance, the lack of receipt of the consumer certificate as asserted is not applicable to the recited determining whether to provide the requested transactional financial assurance. If there is no consumer certificate, then there can not be any determination made based on the consumer certificate since, after all, the consumer certificate is absent.

Williams fails to render obvious “issuing electronic signals representing transactional financial assurance to a relying party” as recited in claim 1

The Payment Manager in Williams is merely an intermediary to facilitate the transaction between the merchant and consumer and does not facilitate issuance of any type of financial assurance as claimed regarding that transaction. Further, the Payment Window of Figure 34 of Williams does not involve issuing signals representing

transactional financial assurance to a relying party. The Payment Window is merely a vehicle for the consumer to issue payment to the merchant. It does not provide any financial assurance to the consumer that, for example, goods will be received, that the merchant is in good standing, etc. Further, as discussed above, the payment authorization (or payment request) of the transaction between the merchant and consumer in Williams is not the financial assurance, as claimed.

Donner

Even assuming *arguendo* that the cited portions of Williams and Donner are properly combinable, Appellant respectfully submits that the cited portions of Donner fail to overcome the deficiencies of the cited portions of Williams. In particular, the Office Action acknowledges that the cited portions of Donner do not disclose or teach anything about claim 1 except allegedly the recited aspect that the transactional financial assurance is other than any payment request or payment authorization of the transaction itself. See Office Action, pg. 4.

For this recited aspect, the Office Action relies on the Abstract, pg. 2, lines 55-58 and pg. 3, lines 9-13 of Donner which generally refers to a local bank computer of the Donner system accessing a credit file on the local bank computer to obtain credit data relating to the source of a bid or offer entered in the central computer.

However, Appellant respectfully submits that the cited portions of Donner simply fail to disclose or teach a transactional financial assurance as claimed. As discussed earlier, an assurance is generally understood to be a promise or pledge or guaranty or surety. Appellant submits that the cited portions of Donner fail to disclose or teach the system of Donner providing a promise or pledge or guaranty or surety regarding the trade it facilitates and executes. The credit rating parameters used in the cited portions of Donner are merely criteria to match offers with bids and thus facilitate trade execution. The credit rating parameters provide no promise or pledge or guaranty or surety regarding the trade; the credit rating information merely provides a general estimate of a party's ability to fulfill its financial commitments.

Moreover, even assuming *arguendo* that the credit rating parameters could be considered a transactional financial assurance, the cited portions of Donner teach away that the credit rating parameters could be a transactional financial assurance as recited in claim 1. For example, the cited portions of Donner fail to disclose or teach that there

may be a request for credit rating parameters to the system of Donner or that credit rating parameters may be issued from the system of Donner to a relying party. Rather, the credit rating parameters are kept at the local computers of each of the traders. There is no request by another trader for the credit rating parameters from another trader and no issuance of credit rating parameters to a trader. See, e.g., Donner, pg. 8, lines 50-57 ("Because each bank's credit file is maintained at a remote local bank computer, the credit file is easily maintained by the trading institution, and confidentially is easily maintained as well... A bank cannot access another bank's credit file through the central computer.")

For similar reasons as provided above, Appellant respectfully submits that the cited portions of Williams and Donner fail to render obvious claims 63 and 68. See pgs. 11-12 of the May 13, 2008 Response for details. Claims 57-62, 64-67 and 69-75 depend from claims 1, 63 or 68 and are, therefore, patentable for at least the same reasons provided above related to claims 1, 63 and 68 respectively, and for the additional features recited therein.

CONCLUSION

Therefore, it is respectfully requested that the panel return a decision concurring with Appellant's position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appealed rejections.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,
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November 19, 2008
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